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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,173	03/09/2001	Chong Seng Cheng	1601457-0004	9334

7590 10/18/2006

White & Case LLP
Attn: Patent Department
1155 Avenue of the Americas
New York, NY 10036

EXAMINER

CHOI, WOO H

ART UNIT	PAPER NUMBER
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2189

DATE MAILED: 10/18/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	09/803,173		CHENG, CHONG SENG	
	Examiner		Art Unit	
	Woo H. Choi		2189	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>08/03/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. The title is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows:

The title was changed to “A Portable Data Storage Device Capable Of Being Directly Connected Via USB Plug To A Computer.” “Directly Connected Via USB Plug To A Computer” is not supported in the original specification.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 22 – 29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

4. With respect to claim 22, the specification as originally filed does not support the limitation “a USB plug integrated into the unitary portable data storage device without an intervening cable capable of coupling portable data storage device directly to a USB socket on a computer”. Closest support for the limitation can be found in figure 1, element 1, and figure 2, step 20 and their corresponding descriptions in the specifications. However, while the specification discloses a USB plug and that “the plug 1 of the device 10 is plugged into 20 to a USB socket on the computer” (specification page 5, lines 18 – 19), it does not disclose that the USB plug 1 of the device is capable of coupling **directly** to a USB socket on a computer. Nor does the specification support the limitation “**without an intervening cable**” limitation.

The specification as originally filed does not support the limitation “a USB plug **integrated into the unitary** portable data storage device”. This limitation has been introduced specifically to avoid a prior art reference applied in one of the previous rejections that discloses a two-piece construction of applicant’s claimed device. The specification is silent as to whether the plug is integrated and the portable device is of unitary construction.

The specification as originally filed does not support the limitation “said memory being **non-removable** from the unitary portable data storage device”. Again, this limitation has been added specifically to avoid a prior art reference applied in one of the previous rejections that discloses applicant’s claimed device with removable memory. Whether the memory is non-removable or not is not disclosed in the specification as originally filed.

The specification as originally filed does not support the limitation "and having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk of CD." While the specification discloses that magnetic disks and CD ROMs are examples of conventional devices, it does not disclose that the claimed non-volatile memory has sufficient capacity to serve as an alternate to a magnetic disk or CD. Capacity of the claimed non-volatile memory is not discussed anywhere in the specification. The specification as originally filed does not support the limitation "in a manner to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD." Applicants are asked to specifically point out where in the specification these limitations are supported.

5. Claims 23 – 29 contain the deficiencies of their parent claim as discussed above.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 22 – 24, and 26 – 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Miller (US Patent No. 6,038,320).

8. With respect to claims 22 – 24, and 28, Miller discloses a unitary portable data storage device (figure 3) comprising:

a USB plug (figure 3, 48) integrated into the unitary portable data storage device without an intervening cable capable of coupling the unitary portable data storage device directly to a USB socket on a computer;

a single interface (figure 3, interface between the plug 48 and the controller 42), said interface allowing the unitary portable data storage device to communicate via the USB protocol and being coupled to the USB plug;

a memory controller (42); and

a non-volatile solid-state memory (46), said memory being non-removable from the unitary portable data storage device and having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD (Miller's device has sufficient capacity to serve as an alternative to other alternative memories, such as a magnetic disk or CD, that can be used to store encrypted passwords); and

the memory controller being coupled between the interface and the memory to control the flow of data between the memory and the USB plug (figure 3, col. 2 line 59 – col. 4, line 7) in a manner to enable the unitary data storage device to serve as an alternative to a magnetic disk or CD.

9. With respect to claim 26, the memory controller comprises a micro-controller (col. 2, line 65).

10. With respect to claim 27, the micro-controller includes a read-only memory which stores a program to control the operation of the micro-controller (col. 3, lines 13 – 15).

11. Claims 22 – 24, and 26 – 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Gilbert (US Patent No. 6,457,099).

Gilbert discloses a unitary portable data storage device (figure 2, 100) comprising:
a USB plug integrated into the unitary portable data storage device without an intervening cable capable of coupling the unitary portable data storage device directly to a USB socket on a computer (col. 7, lines 11 – 30, just like applicant's device, Gilbert's device plugs into a computer, see lines 23 – 24);

a single interface, said interface allowing the unitary portable data storage device to communicate via the USB protocol and being coupled to the USB plug (a USB interface is required for the USB embodiment of Gilbert's device) ;

a memory controller (figure 1, 102, 104);

and a non-volatile solid-state memory (figure 1, 106, 108, 110, 112, see also col. 3, lines 42 – 47 and col. 4, lines 16 – 22), said memory being non-removable from the unitary portable data storage device and having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD (Gilbert's device has sufficient capacity to store applications);

the memory controller being coupled between the interface and the memory to control the flow of data between the memory and the USB plug in a manner to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD.

Claim Rejections - 35 USC § 103

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Miller in view of Kondo *et al.* (US Patent No. 6,786,417, hereinafter "Kondo").

Miller discloses all of the limitations of the parent claim as discussed above. However, Miller does not specifically disclose a manually operated switch movable between a first position in which writing of data to the memory is enabled, and a second position in which writing of data to the memory is prevented. On the other hand, Kondo discloses a flash memory device with a manually operated switch movable between a first position in which writing of data to the memory is enabled, and a second position in which writing of data to the memory is prevented (figures 3 and 4, element 6 activates the switch, col. 4, line 65 – line 3).

It would have been obvious to one of ordinary skill in the art, having the teachings of Miller and Kondo before him at the time the invention was made, to use the accidental erasure prevention teachings of the compact portable flash memory card of Kondo in the compact portable flash memory card of Miller, in order to prevent accidental erasures of flash memory content (Kondo, col. 1, line 66 – col. 2, line 1).

14. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert in view of Kondo.

Gilbert discloses all of the limitations of the parent claim as discussed above. However, Gilbert does not specifically disclose a manually operated switch movable between a first position in which writing of data to the memory is enabled, and a second position in which writing of data to the memory is prevented. On the other hand, Kondo discloses a flash memory device with a manually operated switch movable between a first position in which writing of data to the memory is enabled, and a second position in which writing of data to the memory is prevented (figures 3 and 4, element 6 activates the switch, col. 4, line 65 – line 3).

It would have been obvious to one of ordinary skill in the art, having the teachings of Gilbert and Kondo before him at the time the invention was made, to use the accidental erasure prevention teachings of the compact portable non-volatile memory card of Kondo in the compact portable non-volatile memory card of Miller, in order to prevent accidental erasures of memory content (Kondo, col. 1, line 66 – col. 2, line 1).

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15. Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Margalit *et al.* (US Patent No. 6,748,541, hereinafter “Margalit”) in view of Jha *et al.* (US Patent No. 6,407,949, hereinafter “Jha”).

Margalit discloses all of the limitations of the parent claim 22 as follows:

a unitary portable data storage device (figure 1, 10) comprising:

a USB plug (col. 4, line 23) integrated into the unitary portable data storage device without an intervening cable capable of coupling the unitary portable data storage device directly to a USB socket on a computer (figure 5B);

a single interface (figure 1, 40), said interface allowing the unitary portable data storage device to communicate via the USB protocol and being coupled to the USB plug;

a memory controller (30); and

a non-volatile solid-state memory (50 and 70, col. 4, lines 35 – 41), said memory being non-removable from the unitary portable data storage device and having sufficient capacity to enable the unitary portable data storage device to serve as an alternative to a magnetic disk or CD (Margalit’s device has sufficient capacity to serve as an alternative to other alternative memories, such as a magnetic disk or CD, that can be used to store user data); and

the memory controller being coupled between the interface and the memory (see figure 1) to control the flow of data between the memory and the USB plug in a manner to enable the unitary data storage device to serve as an alternative to a magnetic disk or CD.

However, Margalit does not specifically disclose that the non-volatile solid-state memory is divided into a plurality of zones, one or more of said plurality of zones requiring a unique password for access. On the other hand, Jha discloses these limitations (figure 4).

It would have been obvious to one of ordinary skill in the art, having the teachings of Margalit and Jha before him at the time the invention was made, to use the zoned password protection teachings of the flash memory Jha in the flash memory device of Margalit, in order to prevent inadvertent erasures or reprogramming of portions of the flash memory (Jha, col. 11, lines 17 – 19).

Response to Amendment

16. Claim 22 has been amended to overcome a prior objection. Corresponding objection is withdrawn.

Response to Arguments

17. Arguments regarding the rejections have been addressed in the last office action mailed on February 3, 2006.

Conclusion

18. This is a continuing examination of applicant's application finally rejected on February 3, 2006. The scope of the only amended claim, claim 29, and the newly added claim 30 is broader than the last claim 29 that was finally rejected in the last action. All claims are drawn to the

same invention claimed before and could have been finally rejected on the grounds and art of record if they had been entered in the earlier presentation. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action in this case. See MPEP § 706.07(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no, however, event will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Woo H. Choi whose telephone number is (571) 272-4179. The examiner can normally be reached on M-F, 9:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Reginald Bragdon can be reached on (571) 272-4204. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Woo H. Choi
October 13, 2006